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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/000,057	11/01/2001	Jason E. Dargontina	06 1421 01 01	9505

26813 7590 04/21/2003

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EXAMINER

RIBAR, TRAVIS B

ART UNIT PAPER NUMBER

1711

DATE MAILED: 04/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/000,057

Applicant(s)

DARGONTINA ET AL.

Examiner

Travis B Ribar

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 13 August 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 1-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 17-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2,3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-16, drawn to a stack of siding, classified in class 428, subclass 423.1.
  - II. Claims 17-20, drawn to a method of making a fiberboard cement product, classified in class 427, subclass 372.2.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II represent separate and patentably distinct inventions. The method found in invention II does not produce the product in invention I. Each inventive group therefore has its own distinct aspects of patentability.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

5. During a telephone conversation with the applicant's representative on April 16, 2003 a provisional election was made with traverse to prosecute the invention of group II, claims 17-20. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-16 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### ***Specification***

7. The disclosure is objected to because of the following informalities:

Page 6, line 23: patent number 4,664,030 should be 4,644,030. Support for this position is found in the applicant's Information disclosure statement.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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9. Claim 20 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

10. The term "...at most a slight change in appearance ..." in claim 20 is a term that renders the claim indefinite. The term "...at most a slight change in appearance..." is not defined by the claim, is not an art-recognized phrase, and the specification does not provide a standard for ascertaining its meaning. One of ordinary skill in the art would not be reasonably appraised of the limitations of this claim.

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takahashi in view of Harper et al. and each of Pears et al. ('925), Overbeek et al., and Loewrigkeit et al.

Takahashi discloses a decorative coating coated on a fiberboard cement substrate (column 3, line 12), but does not include the further step of coating the decorative layer with a topcoat layer.

Each of Pears et al. ('925), Overbeek et al., and Loewrigkeit et al. are cited by the applicant as disclosing topcoat layers suitable for the present invention (page 6, lines 20-25 of the applicant's specification) and are included in the applicant's Information Disclosure Statement. Each of these references also disclose that the topcoat layers they disclose are useful in coating applications and provide a hard protective surface to a substrate (column 17, lines 30-38 in Pears et al. ('925); column 18, lines 56-61 and example 1 in Overbeek et al.; column 2, lines 56-62 in Loewrigkeit et al.). The topcoat layers in these references are all polyurethane dispersions prepared below 100°C, meeting those aspects of claim 19, and since the applicant cites them as applicable to the present invention and because there is some data within the references referring to resistance properties, the examiner takes the position that the topcoat layers in the references inherently possess the durability required in claim 20. Here the examiner notes that though the references do not explicitly call for coatings thicker than 8 microns, it would be obvious to coat a substrate with a coating thicker than 8 microns in order to fully utilize the protective properties of the topcoat and to provide a longer lasting coating layer. The references therefore render obvious the thickness limitation of claim 19.

These references do not teach, however, the exact fiberboard composition in claim 19 or that the fiberboard is siding (claim 17).

Harper et al. discloses fiberboard cement that is made from wood pulp (column claim 8), silica (claim 5), and cement (claim 1), meeting the compositional requirements of claim 19. In addition, Harper et al. teaches that such fiberboard is useful in external

building purposes (column 4, line 48), immediately envisioning its use as siding. The reference therefore fulfills the siding requirement of claim 17.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to coat the coated substrate in Takahashi with the coatings in Pears et al. ('925), Overbeek et al., or Loewrigkeit et al. The motivation for doing so would be to provide a hard protective coating to the coated substrate. Therefore it would have been obvious to combine Pears et al. ('925), Overbeek et al., Loewrigkeit et al. and Harper et al. with Takahashi to obtain the invention as specified in claims 17-20.

13. Claims 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takahashi et al. in view of Harper et al. and each of Pears et al. ('925), Overbeek et al., and Loewrigkeit et al.

Takahashi et al. discloses a decorative coating coated on a fiberboard cement substrate (column 2, lines 50-51), but does not include the further step of coating the decorative layer with a topcoat layer.

Each of Pears et al. ('925), Overbeek et al., and Loewrigkeit et al. are cited by the applicant as disclosing topcoat layers suitable for the present invention (page 6, lines 20-25 of the applicant's specification) and are included in the applicant's Information Disclosure Statement. Each of these references also disclose that the topcoat layers they disclose are useful in coating applications and provide a hard protective surface to a substrate (column 17, lines 30-38 in Pears et al. ('925); column 18, lines 56-61 and example 1 in Overbeek et al.; column 2, lines 56-62 in Loewrigkeit

et al.). The topcoat layers in these references are all polyurethane dispersions prepared below 100°C, meeting those aspects of claim 19, and since the applicant cites them as applicable to the present invention and because there is some data within the references referring to resistance properties, the examiner takes the position that the topcoat layers in the references inherently possess the durability required in claim 20. Here the examiner notes that though the references do not explicitly call for coatings thicker than 8 microns, it would be obvious to coat a substrate with a coating thicker than 8 microns in order to fully utilize the protective properties of the topcoat and to provide a longer lasting coating layer. The references therefore render obvious the thickness limitation of claim 19.

These references do not teach, however, the exact fiberboard composition in claim 19 or that the fiberboard is siding (claim 17).

Harper et al. discloses fiberboard cement that is made from wood pulp (column claim 8), silica (claim 5), and cement (claim 1), meeting the compositional requirements of claim 19. In addition, Harper et al. teaches that such fiberboard is useful in external building purposes (column 4, line 48), immediately envisioning its use as siding. The reference therefore fulfills the siding requirement of claim 17.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to coat the coated substrate in Takahashi et al. with the coatings in either Pears et al. ('925), Overbeek et al., or Loewrigkeit et al. The motivation for doing so would be to provide a hard protective coating to the coated substrate. Therefore it would have been obvious to combine Pears et al. ('925), Overbeek et al., Loewrigkeit et



al. and Harper et al. with Takahashi et al. to obtain the invention as specified in claims 17-20.

14. Claims 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pears et al. ('827) in view of Harper et al. and each of Pears et al. ('925), Overbeek et al., and Loewrigkeit et al.

Pears et al. ('827) discloses a coating coated on a fiberboard cement substrate (column 11, line 47). The coating may include dyes and pigments (column 11, line 52), so the coating falls under the definition of 'decorative'. However, Pears et al. ('827) does not include the further step of coating the decorative layer with a topcoat layer.

Each of Pears et al. ('925), Overbeek et al., and Loewrigkeit et al. are cited by the applicant as disclosing topcoat layers suitable for the present invention (page 6, lines 20-25 of the applicant's specification) and are included in the applicant's Information Disclosure Statement. Each of these references also disclose that the topcoat layers they disclose are useful in coating applications and provide a hard protective surface to a substrate (column 17, lines 30-38 in Pears et al. ('925); column 18, lines 56-61 and example 1 in Overbeek et al.; column 2, lines 56-62 in Loewrigkeit et al.). The topcoat layers in these references are all polyurethane dispersions prepared below 100°C, meeting those aspects of claim 19, and since the applicant cites them as applicable to the present invention and because there is some data within the references referring to resistance properties, the examiner takes the position that the topcoat layers in the references inherently possess the durability required in claim 20.

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Here the examiner notes that though the references do not explicitly call for coatings thicker than 8 microns, it would be obvious to coat a substrate with a coating thicker than 8 microns in order to fully utilize the protective properties of the topcoat and to provide a longer lasting coating layer. The references therefore render obvious the thickness limitation of claim 19.

These references do not teach, however, the exact fiberboard composition in claim 19 or that the fiberboard is siding (claim 17).

Harper et al. discloses fiberboard cement that is made from wood pulp (column claim 8), silica (claim 5), and cement (claim 1), meeting the compositional requirements of claim 19. In addition, Harper et al. teaches that such fiberboard is useful in external building purposes (column 4, line 48), immediately envisioning its use as siding. The reference therefore fulfills the siding requirement of claim 17.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to coat the coated substrate in Pears et al. ('827) with the coatings in either Pears et al. ('925), Overbeek et al., or Loewrigkeit et al. The motivation for doing so would be to provide a hard protective coating to the coated substrate. Therefore it would have been obvious to combine Pears et al. ('925), Overbeek et al., Loewrigkeit et al. and Harper et al. with Pears et al. ('827) to obtain the invention as specified in claims 17-20.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Travis B Ribar whose telephone number is (703) 305-3140. The examiner can normally be reached on 8:30-5:00 Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (703) 308-2462. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Travis B Ribar  
Examiner  
Art Unit 1711

TBR  
April 17, 2003



James J. Seidleck  
Supervisory Patent Examiner  
Technology Center 1700